

REMARKS

Finality of the Rejection

Applicant respectfully submits that the present rejection should not have been made final. According to the *MPEP*, at § 706.07(a), “a second or any subsequent action on the merits in any application or patent undergoing reexamination proceedings will not be made final if it includes a rejection, on newly cited art, [...] of any claim not amended by applicant or patent owner in spite of the fact that other claims may have been amended to require newly cited art.” Additionally, “a second or any subsequent action on the merits in any application or patent involved in reexamination proceedings should not be made final if it includes a rejection, on prior art not of record, of any claim amended to include limitations which should reasonably have been expected to be claimed.”

It is respectfully submitted that claim 1, which was previously amended to include the limitations of claim 4, is essentially an un-amended claim, the claim essentially restating claim 4 in independent form. The additional amendment adding the limitation “alphanumeric” to the term “keyboard” is more cosmetic than substantive in nature, and should not form a basis for a new ground of rejection.

Further, it is respectfully submitted that both the incorporation of claim 4 into claim 1 and the clarification of “a keyboard” as “an alphanumeric keyboard” are amendments that include limitations which should reasonably have been expected to be claimed, and any search conducted by the Examiner would have taken such limitations into account.

For these reasons, it is respectfully requested that the Examiner withdraw the finality of the last Office Action, and reopen prosecution of the application in fairness to applicant, who should be afforded the opportunity to contest the new rejection.

Rejection of claim 6 under 35 U.S.C. § 112

Claim 6 currently stand rejected as failing to comply with the enablement requirement. The Examiner states that it is unclear what is meant by a “standard 85-

key keyboard”, noting that the Examiner’s own “standard” keyboard has 104 keys. It is respectfully submitted that a “standard 85-key keyboard” would be known to those skilled in the art as referring to a type of keyboard commonly found on a “notebook computer”, “laptop computer”, “tablet PC”, and other applications where another keyboard standard, such as the Examiner’s 104-key keyboard, is undesirable. The Examiner is referred to a product specification (*Versa Aptitude Product Specifications*, http://www.nec-asia.com/minisites/Aptitude/Aptitude_specs.htm, downloaded on April 25, 2005) for a laptop computer manufactured by the NEC Corporation, provided as an attachment hereto. The product specification refers to a user interface including an “85 keys standard keyboard.”

Moreover, a GOOGLE search performed by Applicant’s representative yielded over 1,700 results for the term “standard 85-key keyboard”, and over 4,000 results for the term “85-key keyboard.” Thus, it is respectfully submitted that the term “standard 85-key keyboard” is sufficiently clear in the specification to enable one skilled in the art to make and use the invention. Withdrawal of this rejection is respectfully requested.

Rejection of claims 1, 2, 3, 6, and 7 under 35 U.S.C. § 103(a)

Claims 1, 2, 3, 6, and 7 currently stand rejected as being unpatentable over Gautier, in view of Paajanen, and further in view of Bae. This rejection is respectfully traversed for the following reasons.

Gautier discloses a portable computer comprising a shell having a top face and four peripheral sides, an LCD display and an alphanumeric keyboard installed in the top face, and a protective cover (rigid flap 5) attached pivotally alongside the shell. The rigid flap has an inner and an outer face. The Examiner notes that Gautier fails to teach a plurality of buttons on the outer face and a cursor controlling device on the inner face. To address these deficiencies in the teachings of Gautier, the Examiner relies on the combination of Gautier with both Paajanen and Bae.

It is respectfully submitted that neither Paajanen, cited for teaching a plurality of buttons on the outer face of a personal computer cover, nor Bae, cited for teaching a

touch pad on the interior of a cover of a cell phone, are properly combinable with Gaultier to establish a basis for rejection of the instant claims.

To establish a *prima facie* case of obviousness under 35 U.S.C. § 103, the rejection must identify some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the cited references. *MPEP* §§ 706.02(j), 2142. When the motivation to combine the references is not immediately apparent, it is the duty of the Examiner to explain why the combination of the references is proper. *MPEP* § 2142. Additionally, the mere fact that the references can be combined does not support a proper obviousness rejection unless the desirability of the combination is also suggested in the prior art. *Id.* And further, the proposed modification or combination of the prior art references cannot render the prior art unsatisfactory for its intended purpose. *MPEP* 2142.01. These requirements are not met by the present rejection.

Gaultier fails to teach or suggest a plurality of buttons on the outer face of the protective cover. Moreover, motivation toward such a modification is lacking. On the contrary, Gaultier explicitly notes that the purpose of the rigid flap is to mask the keyboard and provide a “tablet enabling a sheet of paper to be lodged for note taking during the flight.” Thus, the purpose and function of the rigid flap is to provide a flat surface suitable for writing. Rather than to suggest a modification of adding buttons to the outer surface of this rigid flap, the more apparent teaching is that the outer surface of the rigid flap is to be, such as a clipboard or other writing surface, suitable for 1) retaining a sheet of paper, and 2) providing a smooth writing surface.

Gaultier thus teaches away from, rather than suggests, the combination with Paajanen’s, or any other pushbuttons on the outer surface of the rigid flap. The Examiner’s observation that pushbuttons “could be placed such that they avoid interfering with the tablet portion (F-P) on the front cover [...]” is an exercise in improper hindsight, speculating about how the references might be modified without regard to what they actually teach or suggest. It should be noted, in this regard, that while the Examiner refers to a “tablet portion”, Gaultier makes no such reference, only referring to the rigid flap as a whole as forming a tablet.

It should also be noted that Gaultier already provides a numeric keyboard on the main keyboard area (6) further belying the need or desirability to modify the outer side of the cover as suggested by the Examiner.

Further, it is noted that the incorporation of both a keyboard and a cursor controlling device in the cover of Paajanen's device requires complex flexible interconnections between the cover and the main body. In contrast, the present invention requires only the interconnections for the cursor controlling device.

As acknowledged by the Examiner, Gaultier fails to teach or suggest a cursor controlling device located on the inner face of the rigid flap. It is respectfully submitted that motivation for such a modification is entirely lacking in the cited documents.

Gaultier discloses the use of directional keys (buttons) located on the top face of the shell. It is apparent that these directional keys are used to manipulate the display, such as to move between display fields or to scroll through a flight plan, during the operation of the device. No suggestion is made of a desirability of an additional cursor controlling device and Gaultier makes clear that the directional keys are "accessible at all times". Thus, assuming that a cursor controlling device would fulfill a role equivalent, or similar, to the directional keys, it would be undesirable for a cursor controlling device to be located in the inner face of the rigid flap of Gaultier. Gaultier actually teaches away from, rather than suggests, a combination with Bae's, or any other cursor controlling device on the inner surface of the rigid flap.

While it is understood that the Examiner has selected Bae for its disclosure of a touchpad on an inner side of a flip cover, it is to be noted that Bae fails to disclose, teach or suggest placement of pushbuttons on the outer surface of the cover in combination with a touchpad on the inside of the cover. It is said that "touch pad member 24 occupies substantially all of the inside planar surface of keypad cover 16, but without adding any significant thickness to the keypad cover". Thus, Bae seems to express a concern about altering the dimensions of the underlying cell phone. The addition of pushbuttons to the outer surface of the cover would apparently work counter to this objective. Additionally, for a device such as a cell phone, which may be a pocket-carried device, in contrast to the portable computer of the present invention,

exteriorly placed pushbuttons may be problematic due to accidental activation of the buttons as the device is carried in a pocket. For such reasons, it is submitted that a person skilled in the art would not be led to move a touchpad as disclosed in Bae to the inside of a cover as shown in Gauthier. Certainly, the documents themselves cannot be said to provide such a suggestion.

It is respectfully submitted that for the foregoing reasons the cited references failed to establish a proper prima facie case of obviousness under 35 U.S.C. § 103. Accordingly, withdrawal of this rejection is respectfully requested.

Statement under 37 CFR 1.116

It is respectfully submitted that entry of this response after final rejection is appropriate in view of citation of prior art for the first time in the Examiner's final rejection notwithstanding the fact that the claims were not substantively amended in response to the previous Office Action.

Applicant did not have the opportunity before the final rejection to address the new issues raised by the Examiner and basic fairness dictates that applicant should have the opportunity to properly address the new grounds for rejection without the need to refile the application.

It is respectfully submitted that there is good cause to reopen the prosecution of this application in the event the Examiner elects not to withdraw the final rejection.

General Comments

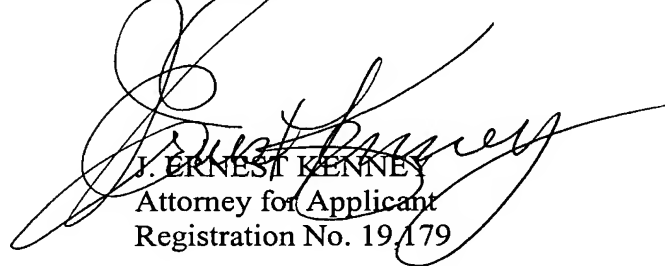
In view of the foregoing remarks, it is respectfully submitted that withdrawal of the rejection of claims 1-3, 6 and 7 is in order and that the application is in condition for allowance. Accordingly, it is requested that the application be passed to issue.

Application No.: 10/622,696
Examiner: Zachary PAPE
Art Unit: 2835

If any issues remain that may be resolved by a telephone or facsimile communication with the Applicant's attorney, the Examiner is invited to contact the undersigned at the numbers shown.

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Respectfully submitted,



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Versa Aptitude Product Specifications

NEC recommends Microsoft® Windows® XP.



Processor	Mobile Intel® Pentium® III Proc 850 MHz featuring Intel® Spec Technology.
Operating System	Microsoft® Windows® Millenium Microsoft® Windows® 2000 Pro
Screen Display	12.1" TFT SVGA / 13.3" TFT XG XGA
Memory	From 64MB to 128MB (100 MHz)
Hard Disk	10GB / 20GB Ultra DMA
Video	ATI Mobility M1 with 8MB video

Audio	ESS Allegro-1 audio controller v built-in dynamic speakers
Communications	Built-in V.90 56kbps fax / mode 10/100Mbps LAN Combo
Floppy Drive	Integrated 1.44MB (3.5")
CD / DVD Drive	24x CD-ROM Drive / 8x DVD-R Writer Drive / CD-RW/DVD Cor
User Interface	NEC VersaGlide™ Touchpad 85 Keys standard keyboard
Size	Foot Print: 308mm x 262 mm Thickness: 37mm x 39.5 mm
Weight	3.3 kg
Battery	8-cells Li-Ion
Software Collection	Microsoft® Word® 2000* Microsoft® Works® 2000* Microsoft® Money® 2000* Norton® AntiVirus 2000 Ulead Video Studio 4.0* Laplink 2000 NEC Smart Restore Microsoft® Internet Explorer 5.1 Acrobat Reader 4.0 Cyberlink Power DVD (Only with configuration) Adaptec Easy CD Creator (Only configuration) * Pre-installed software may differ from d specifications.



Versa Aptitude

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